

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number 042933/253133

**(filed with the Notice of Appeal)**

Application Number 09/977,894

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First Named Inventor Cheol-Woong Lee

Art Unit 2135

Examiner Patel, Nirav B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Attachment  
Reasons for Requesting Pre-Appeal Brief Request For Review

**I. Independent claims 1, 7 and 15 are patentable over Abdelnur, Hooper and Grube**

Independent claims 1, 7 and 15, which are directed to a system and methods for sharing digital literary works while protecting against an illegal reproduction through a communication network, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur et al. (U.S. Patent No. 6,212,640, hereinafter “Abdelnur”) in view of Hooper et al. (U.S. Patent No. 5,414,455, hereinafter “Hooper”) and further in view of Grube et al. (U.S. Patent No. 5,594,796, hereinafter “Grube”).

Independent claims 1, 7 and 15 provide for a digital literary work having an identifier to be input into a server by a supervisor. The digital literary work may then be shared. However, independent claims 1, 7 and 15 recite, *inter alia*, the decision regarding shareability being based only on existence of the identifier in the digital literary work. Thus, in an exemplary embodiment according to independent claims 1, 7 and 15, a digital literary work is examined for the existence of an identifier and shared based only on the existence of the identifier. In other words, for example, if there is no identifier the digital literary work may not be shared, but if there is an identifier, the digital literary work may be shared.

Abdelnur is directed to a method and apparatus for sharing resources in a network environment. However, Abdelnur is silent, as conceded in the Office Action, regarding a digital literary work including an identifier. As such, the Office Action cites Hooper as teaching such feature at Figure 3 and col. 6, lines 13-15. The cited passage from Hooper discloses a video (100) that includes packets (110) having a packet header (120) and packet data (140) (col. 6, lines 7-11, Figure 3). The packet header (120) includes an ID (121), a RATE (122), a TIME-STAMP (123), and a PACKET-SIZE (125). It should be noted that the ID (121) identifies the particular video. However, none of the ID (121), the RATE (122), the TIME-STAMP (123), or the PACKET-SIZE (125) is used as a basis for a determination as to whether to share the video (100). Accordingly, Hooper fails to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15.

In order to cure the deficiency of Abdelnur and Hooper, the Office Action cites Grube. Specifically, the Office Action alleges that the recited feature is disclosed by virtue of the

security tag of FIGS. 1, 2, 3 and the description at col. 5, lines 50-60 and col. 6, lines 33-45 and 65-66 of Grube.

In response to Applicants' prior arguments, the final Office Action maintains that Grube discloses the feature above. In this regard, the Office Action cites the following passages of Grube, namely col. 2, lines 50-53, col. 3, lines 63-65 and col. 4, lines 1-7 (see "Response to Arguments" on page 21), and then concludes that "the secure gateway determines the tag/identifier from the data and decides whether further distribution/shareability of the data is allowable based on the comparison (i.e. if the tag/identifier match with authorized database then the distribution is allowed otherwise the distribution is prevented/prohibited"). However, there is no basis for the conclusion made in the Office Action based on the cited passages, in particular, or all of Grube, in general.

Col. 2, lines 50-53 describe the goal of Grube, which is to identify and prevent unauthorized distribution of data within a wireless communication system. No further description of the mechanism for achieving the stated goal is provided in this portion of Grube. Col. 3, lines 63-65 of Grube describe how, during routing of data, a check is made for a security tag. If no tag is found, one is inserted. Col. 4, lines 1-7 describe how an unauthorized distributor is identified based on the identities provided in the security tag. Thus, the only logical conclusion permitted by the cited passages of Grube is that unauthorized distributors are identified based on the security tag. No action on the basis of such identification is provided. Thus, the cited passages of Grube fail to provide any basis for the conclusion that a decision is made on the shareability of data. Moreover, the remainder of Grube also fails to provide any basis for the conclusion quoted above.

Grube is directed to a method and apparatus for detecting unauthorized distribution of data. In this regard, Grube discloses that a security tag may be searched for (operation 301 of FIG. 3) in response to the receipt of data from a particular data base (operation 300 of FIG. 3). However, in Grube the existence of the security tag is not used to determine whether to share data, but instead is only used for determining whether to add a security tag or examine an existing tag for a match with a stored database identification as described above. Grube goes on to disclose an additional determination regarding whether a security tag is valid by comparing a detected security tag to a stored database identification (col. 5, lines 50-54). If the security tag is valid, it is ignored (col. 5, lines 55-56). However, if the security tag is invalid, then the

authorized distributor is informed (operation 307 of FIG. 3). As such, a decision regarding whether to share data according to Grube is not based on the existence of an identifier. Instead, Grube merely uses the existence of an identifier to determine whether to add an identifier and the identifier is subsequently examined for validity to determine whether to inform an authorized distributor of an unauthorized distributor. Moreover, there is not even a decision regarding whether to share data in Grube, much less determining whether to share data based only on the existence of an identifier. Thus, there is no basis for the conclusion presented at page 21 of the final Office Action since Grube fails to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15.

Since Abdelnur, Hooper and Grube, each fail to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15, any combination of Abdelnur, Hooper and Grube also fails to teach or suggest the subject matter of independent claims 1, 7 and 15. Accordingly, independent claims 1, 7 and 15 are patentable over Abdelnur, Hooper and Grube.

## **II. The dependent claims are patentable over the cited references**

Dependent claims 2-4, 8, 10, 13, 16, 18 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and further in view of Grube. Claims 5, 11 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and Grube, and further in view of Wiser et al. (U.S. Patent No. 6,385,596, hereinafter, “Wiser”). Claims 6, 12 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and Grube, and further in view of Moskowitz (U.S. Patent No. 6,598,162). Claims 9 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and Grube, and further in view of Halabieh (U.S. Patent No. 6,564,170). Claims 14 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and Grube, and further in view of Natarajan (U.S. Patent No. 6,611,599). Claims 23-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abdelnur in view of Hooper and Grube, and further in view of Yoshiura (U.S. Patent No. 6,131,162).

Halabieh is directed to customizable user interfaces. Yoshiura is directed to a digital authentication method. Natarajan, Moskowitz and Wiser are each directed to encryption methods. Halabieh, Natarajan, Moskowitz, Wiser and Yoshiura each fail to teach or suggest that the decision regarding shareability being based only on existence of the identifier in the digital literary work as claimed in independent claims 1, 7 and 15. Furthermore, none of Halabieh, Natarajan, Moskowitz, Wiser and Yoshiura is cited as disclosing such feature.

Since Abdelnur, Hooper, Grube, Halabieh, Natarajan, Moskowitz, Wiser and Yoshiura each fail to teach or suggest the same aforementioned feature of independent claims 1, 7 and 15, any combination of Abdelnur, Hooper, Grube, Halabieh, Natarajan, Moskowitz, Wiser and Yoshiura also fails to teach or suggest the subject matter of independent claims 1, 7 and 15. Thus, the cited references, taken either individually or in combination, do not anticipate, or render independent claims 1, 7 and 15 obvious. Claims 2-6, 8-14 and 16-25 depend either directly or indirectly from a respective one of independent claims 1, 7 and 15, and as such, include all the recitations of their respective independent claims. The dependent claims 2-6, 8-14 and 16-25 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1, 7 and 15.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 9-11 under 35 U.S.C. §102(e) should be reversed.